DETAILED ACTION

Acknowledgement is made to Applicant's response and amendments dated August 24, 2009. Claims 35-61 and 63-77 are the subject of this office action. Claim 62 has been cancelled and claims 40 and 78-83 have been withdrawn.

Rejections Withdrawn

The 35 U.S.C. 112 rejection of claim 68 is withdrawn based upon the amendment to the claim.

The 35 U.S.C. 103(a) rejection over De La Poterie in view of El-Nokaly et al. of claims 35-39, 41-50 and 60-77 is withdrawn in light of Applicant's statement regarding obligation of assignment.

The double patenting rejection of claims 35-39, 40-50 and 60-77 over claims 1-53 of U.S. 6949504 in view of 6464969 and 5843407 is withdrawn.

The double patenting rejection of claims 35-39, 40-50 and 60-77 over claims 1-63 of U.S. 7129276 in view of 6464969 and 5843407 is withdrawn.

Further note that the instant species election requirement in regards to the semi-crystalline polymer has been withdrawn upon further consideration by the examiner.

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file. The examiner further notes the submission of the translation of foreign priority documents on August 24, 2009.

Specification

The amendment filed in on June 9, 2005 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The amendment claims priority to French Application 02/00885, filed on January 24, 2002 and French Application 02/02358, filed on February 25, 2002. The priority applications cannot be incorporated by reference after the original filing of the instant application. This objection can be overcome by removing the incorporation by reference statement.

See United States Patent and Trademark Office OG Notices: 1268 OG 89 (18 March 2003) "Benefit of Prior-Filed Application" (see Part VII).

Applicant is required to cancel the new matter in the reply to this Office Action.

New Grounds of Rejection

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 51-59 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 51-59 recite, "wherein the at least one semi-crystalline polymer is…" This is indefinite because the independent claim 35 recites a

mixture of semi-crystalline polymers and it is unclear which polymer Applicant is intending to limit. Further clarification is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 35-61 and 63-77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tournilhac (EP 1034776 A1, published September 13, 2000) in view of Stewart (U.S. 5,156,911, issued October 20, 1992).

The Tournilhac reference teaches a makeup composition in paragraph [0010] comprising a liquid fatty phase having an effective amount of a semi-crystalline olefin copolymer (i.e. crystallinity from 5 to 40%), a pigment (para [0014]), where the liquid fatty phase is dispersed in a volatile oil such as isononyl isononanoate (para [0066-0067]). Tournilhac teaches that the copolymers have a melting point lower than 150 degrees Celsius, preferably lower than or equal to 110 degrees Celsius. Tournilhac further teaches the use of these copolymers in combination (para [0062-0063]).

Tournilhac, while teaching a high melting point copolymer (150 degrees Celsius or less), does not appear to explicitly teach the use of a low melting point polymer in combination with the high melting point copolymer of the invention.

Stewart teaches an adhesive composition comprising a polymer having a melting point within the range of 20 to 35 degrees Celsius that has little or no tack at room temperature and becomes tacky upon contact with the skin (column 4, lines 35-52). Examples 5 and 7 of Stewart exemplify the adhesive composition of the invention and reiterates the adhesive properties of the invention.

It would have been prima facie obvious to one having ordinary skill in the art at the time of the invention to combine the teachings of Tournilhac with the polymer taught by Stewart. One would have been motivated to do so because Stewart teaches that the low melting point polymers have advantageous properties such as improved adhesion to the skin. This is advantageous to the invention of Tournilhac as it is drawn to makeup compositions such as semi-permanent tattooing (para [0002]) with transfer and water resistant properties (para [0008]).

It is noted that in order to rely on a reference under 35 U.S.C. 103, that the reference must be analogous prior art. KSR states that "Under the correct analysis, any need or problem known in the field of endeavor at the time of the invention and addressed by the patent [or application at issue] can provide a reason for combining the elements in the manner claimed." Although the Stewart reference may appear to be in a field different from applicant's endeavor, it is still pertinent to the invention as a whole because it teaches the use of polymers with adhesive properties. Polymers with adhesive properties are pertinent to makeup compositions such as those taught by Tournilhac because they impart additional transfer resistance and resistance to wash off

to the composition. Further, adhesive properties are useful in makeup applications such as semi-permanent tattoos and stage makeup.

Regarding claim 35, Tournilhac teaches a makeup composition in paragraph [0010] comprising a liquid fatty phase having an effective amount of a semi-crystalline olefin copolymer (i.e. crystallinity from 5 to 40%), a pigment (para [0014]), where the liquid fatty phase is dispersed in a volatile oil such as isononyl isononanoate (ester of claim 35) (para [0066-0067]). Tournilhac teaches that the copolymers have a melting point of lower than 150 degrees Celsius, preferably lower than 110 degrees Celsius (para [0020]).

Regarding the "wherein…" statement, claim scope is not limited by claim language that does not limit a claim to a particular structure (MPEP 2144.05), however, note that Tournilhac teaches that the composition is physiologically acceptable (para [0013]).

Regarding claims 36-39 and 41-42, Tournilhac teaches isononyl isononanoate (para [0066]).

Regarding claims 43-44, Tournilhac teaches the oils in an amount ranging from 30 to 99% of the composition, overlapping and thus making prima facie obvious the instantly claimed ranges.

Regarding claims 45-48, Tournilhac does not appear to teach the specific ranges, however, it would have been prima facie obvious to one having ordinary skill in the art at the time of the invention to optimize the ranges of the ingredients of the claims. One would have been motivated to do so dependent upon the desired final

properties of the formulation (i.e. skin feel, thickness of composition, etc) and further motivated by the suggestion of Tournilhac that the amount of oil can be varied from 30 to 99% while still achieving successful results. Further, "[w]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

Regarding claims 49-50, Tournilhac teaches the polymers of the invention have a molecular mass of greater than 30,000, overlapping and thus making prima facie obvious the instantly claimed ranges. Also note that although Stewart does not appear to explicitly teach the molecular mass of the polymers, Stewart does teach the melting points of the respective polymer. The examiner asserts that the molecular masses of Stewart are likely overlapping due to the similar melting points of the polymers taught by the art and the polymer of the instant invention. Also note that page 17 of the instant specification lists the polymers of Stewart as acceptable for use as the low melting point polymer of the invention. Further, it would have been prima facie obvious to one having ordinary skill in the art at the time of the invention to optimize the molecular mass of the polymer of Stewart. One would have been motivated to do so dependent upon the desired final adhesiveness of the polymer.

Regarding claim 51, Tournilhac teaches the copolymer can be solubilized in the fatty phase by heating it to the top of its melting point (para [0037]).

Regarding claim 52, Tournilhac teaches olefin copolymers with controlled crystallinity (para [0016]).

Regarding claim 53, Stewart teaches side chain crystallizable polymers where monomer units X have a side chain defined by “S" and "C" where "S" and "C" are named as linear aliphatic side chains of at least 10 carbon atoms. It is the position of the examiner that a side chain having a large carbon chain would be hydrophobic. (column 5 line 65 to column 6 line 48)

Regarding claim 54, Stewart teaches the semi-crystalline polymer having M as a backbone atom, S as a spacer, C as a crystallizable group where S-C can be a alkyl carbon chain having at least 10 carbon atoms (column 6, lines 5-48).

Regarding claims 55-59, Stewart teaches that the polymers contain typical monomer “X” and “Y” units such as acrylic acid, methacrylic acid, C14-C22 acrylates or methacrylates, vinyl ethers or esters, alpha olefins and hydrophilic monomers. See column 6, lines 5-48 and column 7, lines 29-35. Stewart further teaches monomer “Z” may be included in the polymers, where monomer “Z” is named as hydroxyethylacrylate.

Regarding claims 60-61, 66-67 and 69-70, the references do not appear to explicitly teach the weight ratio of the polymer combination. However, it would have been prima facie obvious to one having ordinary skill in the art at the time of the invention to optimize the amounts of the polymers during the routine experimentation process. One would have been motivated to do so in light of the suggestions by Tournilhac and Stewart that the amounts of the polymers can successfully be varied, and further in light of the teaching by Stewart that the low melting point polymer of the invention affords adhesive properties to a composition. Therefore, the skilled artisan

would have been motivated to vary the content of the polymer of Stewart dependent upon the desired adhesive properties of the final composition. For example, in the embodiment of Tournilhac that teaches the invention as a semi-permanent tattoo, the skilled artisan would be motivated to include more of the polymer of Stewart so as to afford increased adhesion properties. Further, "[w]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

Regarding claims 63-64, Tournilhac teaches that the copolymers have a melting point of lower than 150 degrees Celsius, preferably lower than 110 degrees Celsius (para [0020]), overlapping and thus making prima facie obvious the instantly claimed range.

Regarding claim 65, Stewart teaches the polymers of the invention as having a melting point within the range of 20 to 35 degrees Celsius (column 4, lines 35-52), overlapping and thus making prima facie obvious the instantly claimed range.

Regarding claim 68, paragraphs [0065] and [0066] of Tournilhac teaches isononyl isononanoate and polar oils and further teaches that more than one oil may be used.

Regarding claim 71, Tournilhac teaches that waxes are present in the amount ranging from 0 to 50% by weight, overlapping and thus making prima facie obvious the claimed range of “less than 10%.” Further, it would have been prima facie obvious to one having ordinary skill in the art at the time of the invention to include a lower amount

of wax motivated by the teaching of Tournilhac that the rate of crystallinity of waxes is not easily controlled and large crystallites may be present when wax is used (para [0004]).

Regarding claim 72, Tournilhac teaches an example comprising, namely the lipstick of example 2, that contains no filler.

Regarding claim 73, Tournilhac teaches the compositions are preferably anhydrous (para [0094]).

Regarding claim 74, Tournilhac teaches that the product can be presented in cast form (para [0093]).

Regarding claim 75, Tournilhac teaches lipstick, eyeliners, foundations, etc. (para [0002] and [0093]).

Regarding claim 77, Tournilhac teaches a makeup composition in paragraph [0010] comprising a liquid fatty phase having an effective amount of a semi-crystalline olefin copolymer (i.e. crystallinity from 5 to 40%), a pigment (para [0014]), where the liquid fatty phase is dispersed in a volatile oil such as isononyl isononanoate (para [0066-0067]). Tournilhac teaches that the copolymers have a melting point of lower than 150 degrees Celsius, preferably lower than 110 degrees Celsius (para [0020]). Tournilhac further teaches the compositions in the form of a lipstick (para [0002] and [0093]).

Claims 35 and 76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tournilhac (EP 1034776 A1, published September 13, 2000) in view of Stewart (U.S. 5,156,911, issued October 20, 1992) as applied to claims 35-37, 40-

42, 44-51, 62-63, 65-76 and 78 above, and in further view of Freund et al. ("Paraffin products: properties, technologies, applications," published 1998).

The Tournilhac reference teaches a makeup composition in paragraph [0010] comprising a liquid fatty phase having an effective amount of a semi-crystalline olefin copolymer (i.e. crystallinity from 5 to 40%), a pigment (para [0014]), where the liquid fatty phase is dispersed in a volatile oil such as isononyl isononanoate (para [0066-0067]). Tournilhac teaches that the copolymers have a melting point lower than 150 degrees Celsius, preferably lower than or equal to 110 degrees Celsius. Tournilhac further teaches the use of these copolymers in combination (para [0062-0063]).

Stewart teaches an adhesive composition comprising a polymer having a melting point within the range of 20 to 35 degrees Celsius that has little or no tack at room temperature and becomes tacky upon contact with the skin (column 4, lines 35-52). Examples 5 and 7 of Stewart exemplify the adhesive composition of the invention and reiterates the adhesive properties of the invention.

Neither reference appears to explicitly teach the hardness of lipstick.

The Freund et al. reference teaches that the hardness of lipstick can be varied by the inclusion of carnauba wax.

The rejection of claims 35 has been discussed supra.

Regarding claim 76, it would have been prima facie obvious to one having ordinary skill in the art at the time of the invention to combine the teachings of Tournilhac and Stewart with the carnauba wax taught by Freund and achieve a lipstick of the claimed hardness. One would have been motivated to do so in light of the

suggestion by Freund that carnauba wax be used to obtain lipstick with a certain hardness and the teaching of Tournilhac that both carnauba and candelilla wax can be included in the preparation (para [0085]) in varying amounts (para [0087]).

Conclusion

Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on August 26, 2009 prompted the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 609.04(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TANIA ASHBY whose telephone number is (571)270-1348. The examiner can normally be reached on Monday through Friday, 7:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila Landau can be reached on (571) 272-0614. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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